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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,529	07/24/2000	PATRICIA KANNOUCHE	192863US0PCT	6934

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EXAMINER	
JOHANNSEN, DIANA B	
ART UNIT	**PAPER NUMBER**
1634	

NOTIFICATION DATE	DELIVERY MODE
04/03/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	09/555,529	KANNOUCHE ET AL.	
	Examiner	Art Unit	
	Diana B. Johannsen	1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 December 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *30,32-39,43-63 and 66-78* is/are pending in the application.

4a) Of the above claim(s) *43-58 and 66-78* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *30,32-39 and 59-63* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

FINAL ACTION

1. This action is responsive to the Amendment filed December 11, 2008. Claims 30, 34, 39, and 59 have been amended and claim 31 has been canceled. Claims 43-58 and 66-78 remain withdrawn as being drawn to a non-elected invention (see the Office action of March 6, 2006). Claims 30, 32-39, and 59-63 are now under consideration. Applicant's amendments and arguments have been thoroughly reviewed. Any rejections and/or objections not reiterated in this action have been withdrawn. **This action is FINAL.**

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

The following are new grounds of rejection necessitated by applicants' amendments:

3. Claims 35 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Applicant has canceled claim 31, from which claims 35 and 39 depend. Accordingly, as the identity of "the isolated polynucleotide of claim 31" is now unknown, it is unclear what is embraced by claims 35 and 39.

Claim Rejections - 35 USC § 112, first paragraph

5. It is noted that because the claim from which claims 35 and 39 depend have been canceled (see preceding rejection), those claims have been interpreted as depending from claim 30.

The following are new grounds of rejection necessitated by applicants' amendments

6. Claims 30, 32-39, and 59-63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **This is a new matter rejection.**

Independent claim 30 (from which claims 32-39 depend) has been amended such that it is directed to "an isolated polynucleotide which encodes a kin17 protein selected from the group consisting of….", wherein the claim then recites a list of nucleic acid sequences. Independent claim 59 (from which claims 60-63 depend) has been amended such that it is directed to "an isolated polynucleotide which encodes a mouse kin17 protein selected from the group consisting of…", wherein the claim then recites a list of nucleic acid sequences. The claims as amended therefore appear to embrace proteins having nucleic acid sequences (rather than just polynucleotides encoding proteins, wherein the polynucleotides have the recited sequences). As such proteins were not disclosed in the originally filed specification, applicant's amendment introduces

new matter. Additionally, while the particular construct of claim 39 was disclosed with regard to the molecule of claim 31 (which is now canceled), applicant's amendment has necessitated the treatment of claim 39 as dependent from pending claim 30. Accordingly, claim 39 also embraces vectors that were not disclosed in the originally filed specification.

7. Claims 30, 32-39, and 59-63 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for isolated polynucleotides selected from the nucleotide sequences set forth in independent claims 30 and 59, does not reasonably provide enablement for isolated polynucleotides encoding proteins selected from these nucleotide sequences. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to: (A) the breadth of the claims; (B) the nature of the invention; (C) the state of the prior art; (D) the level of one of ordinary skill; (E) the level of predictability in the art; (F) the amount of direction provided by the inventor; (G) the existence of working examples; and (H) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) (*MPEP* 2164.01(a)).

Independent claim 30 (from which claims 32-39 depend) has been amended such that it is directed to "an isolated polynucleotide which encodes a kin17 protein selected from the group consisting of....", wherein the claim then recites a list of nucleic acid sequences. Independent claim 59 (from which claims 60-63 depend) has been amended such that it is directed to "an isolated polynucleotide which encodes a mouse kin17 protein selected from the group consisting of…", wherein the claim then recites a list of nucleic acid sequences. The claims as amended therefore appear to embrace proteins having nucleic acid sequences (rather than just polynucleotides encoding proteins, wherein the polynucleotides have the recited sequences). Both the specification and the prior art are silent with regard to such proteins. Further, it is well-known to those of ordinary skill in the relevant art that proteins are composed of amino acids. Accordingly, it would require undue experimentation to make this embodiment embraced by applicant's claims.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diana B. Johannsen whose telephone number is 571/272-0744. The examiner can normally be reached on Monday and Thursday, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached at 571/272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Diana B. Johannsen/
Primary Examiner, Art Unit 1634